

REMARKS

This is a response to the Office Action dated March 01, 2006.

I. SUMMARY OF OFFICE ACTION

In the Office Action, the Examiner rejected claims 14 and 15 under 35 U.S.C. §112, second paragraph, based on the view that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner referred to the limitation “the polling technique,” as insufficient antecedent basis for the limitation in Claim 14. (Office Action, pg. 2, para. 3). The Examiner rejected Claim 15 as indefinite because Claim 15 is dependent upon Claim 14.

Claims 1-9, 11, 12, 14, and 15 were rejected under 35 U.S.C. § 102(b) based on the view that the claims are anticipated by Alfaro et al., 5491418. Alfaro et al. as understood by Applicant discloses a diagnostic tool with a “vehicle specific connector adapter including an electrical element coded to identify the communications configuration of the vehicle electrical devices that are to be diagnosed. The vehicle is interfaced to the tool via the connector adapter. When interfaced to the vehicle, the diagnostic tool automatically reads the electrical element code and thereby identifies the communication configuration.” (Column 1, lines 59-67)

Claims 10, 13, and 16-23 were rejected under 35 U.S.C. § 103(a) based on the view that the claims are unpatentable over Alfaro et al.

II. APPLICANT'S RESPONSE

A. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

In the Office Action, Claim 1 was rejected under 35 U.S.C. § 102(b) based on the view that the claims are anticipated by Alfaro et al. Applicant respectfully disagrees with Examiner regarding the anticipation rejection. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *MEHL/Biophile Int'l. Corp. v. Milgram*, 192 F.3d 1362 (Fed. Cir. 1999). The Alfaro et al. patent specification includes the following description: “automatic vehicle identification and diagnostic tool initialization are provided through a **vehicle specific connector** adapter including an electrical element coded to identify the communications configuration of the vehicle electrical devices that

are to be diagnosed. The vehicle is interfaced to the tool via the connector adapter.” (Column 1, lines 59-64). In other words, the Alfaro et al. patent identifies a **vehicle specific connector** for determining the communications configuration of the vehicle electrical devices that are to be diagnosed. Applicant’s invention embodies a specific communications protocol to determine the communications configuration for the vehicles on-board diagnostic system. Claim 1 recites, “comparing the retrieved cable identification data with at least one look-up table to identify a correlated communications protocol.” An aspect of the invention as recited in Claim 1 includes obtaining information and identifying a specific communications protocol. The specific communications protocol for the on-board diagnostic system of the vehicle as embodied in Applicant’s invention is easily distinguishable from a vehicle specific connector described in the Alfaro et al. patent. Therefore, Alfaro et al. does not anticipate Claim 1 because Alfaro et al. does not disclose a vehicle interfaced to the device via a specific communications protocol. Applicant respectfully submits that Claim 1 overcomes the Examiner’s rejection under 35 U.S.C. §102 (b).

The remaining dependent claims of Claim 1, namely Claims 2-9, 11, and 12 are believed to be in condition for allowance for containing additional patentable subject matter.

B. CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

i. Claims 10 and 13

In the Office Action, Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Alfaro et al. The Examiner based the rejection of Claim 10 on the view that it would have been obvious to one of ordinary skill in the art that “the second connector is a standardized OBD-II connector or polling when one is present.” (Office Action, pg. 3, para. 10). Applicant respectfully disagrees with Examiner’s obviousness rejection of Claim 10. Claim 10 depends upon Claim 1, which as recited above includes, “the retrieved cable identification data with at least one look-up table to identify a correlated communications protocol.” In other words, Applicant’s invention uses a look-up table to identify a specific communications protocol. Alfaro et al. on the other hand requires a vehicle specific connector. Hence, Applicant’s invention is different concerning the communications protocol.

Furthermore, Claim 10 recites, “determining from the retrieved cable identification data whether the second connector is a standardized OBD-II connector.” An aspect of Applicant’s

invention determines whether the second connector is a standardized OBD-II connector based on the information obtained from the cable connected to the diagnostic device. Therefore, Claim 10 does not assume a standardized OBD-II connector for the second connector; rather it determines the type of connector. Applicant respectfully submits that the Alfaro et al. patent does not disclose, suggest or make obvious such limitation. Applicant respectfully submits that Claim 10 overcomes the Examiner's rejection under 35 U.S.C. §103 (a).

In the Office Action, Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Alfaro et al. The Examiner based the rejection of Claim 13 on the view that it would have been obvious to one of ordinary skill in the art that a polling technique is implemented to determine the communications protocol. Applicant respectfully disagrees with Examiner's obviousness rejection of Claim 13. The Examiner merely states that in view of Alfaro et al. it is obvious to one of ordinary skill in the art to use a polling technique to determine the specific communications protocol when the second connector is a standard OBD-II connector. Claim 1 of Applicant's invention recites, "a correlated communications protocol." Alfaro et al. does not disclose a specific communications protocol, therefore it would not follow logically that Applicant's invention would be obvious in using the polling technique to determine the specific communications protocol. Applicant respectfully submits that Alfaro et al. does not disclose, suggest or make obvious such limitation. Applicant respectfully submits that Claim 13 overcomes the Examiner's rejection under 35 U.S.C. §103 (a).

ii. Claim 16

In the Office Action, Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Alfaro et al. The examiner based the rejection of Claim 16 on the view that it would have been obvious to one of ordinary skill in the art for a diagnostic device "containing any protocol software because it is a design choice." (Office Action, pg. 3, Para. 10). Referring again to section A's recitation of Claim 1, Applicant's invention discloses a specific communications protocol. Alfaro et al. on the other hand, discloses a vehicle specific connector. Claim 16 as amended recites, "a sequencer comprising, a look up table selectively accessed for identifying OBD-I functionality; and a look up table selectively accessed for identifying OBD-II functionality; and a look up table selectively accessed for a plurality of OBD-I communications protocols; and a look up table selectively accessed for a plurality of OBD-II communications protocols." Therefore, using a sequencer to determine the specific communications protocol

would not have been obvious under Alfaro et al. because Alfaro et al. contemplates a vehicle specific connector. Applicant respectfully submits that Alfaro et al. does not disclose, suggest or make obvious such limitation. Applicant respectfully submits that Claim 16 overcomes the Examiner's rejection under 35 U.S.C. §103 (a).

The dependent claims of Claim 16 are also believed to be in condition for allowance. Namely, Claims 17-23 for containing additional patentable subject matter and for being dependent upon an allowable base claim.

C. CLAIM REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

In the Office Action, Claims 14 and 15 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action states that Claim 14 recites "the polling technique." The Office Action states that there is insufficient antecedent basis for the limitation in the claim. The Office Action states that Claim 15 is indefinite for depending on Claim 14. By this amendment, Applicant amends Claim 14 to depend on Claim 13 rather than Claim 11. Applicant respectfully submits that such amendment to Claim 14 overcomes the Examiner's rejection of Claim 14 under 35 U.S.C. §112, second paragraph. Claim 15 is believed to be in condition for allowance as being dependent upon Claim 14.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully submits that all the stated grounds of rejection have been overcome, and that Claims 1-23 are in condition for allowance. An early notice of allowance is therefore respectfully requested.

Should the Examiner have any suggestions for expediting allowance of the application, the Examiner is invited to contact the Applicant's representative at the telephone number listed below.

Application No.: 10/779,985
Attorney Docket: EQUUS-106A

If any additional fee is required, please charge deposit account number 19-4330.

Respectfully submitted,

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